REMARKS:

Claims 1-31 are currently pending in the application.

Claims 32-50 have been previously canceled without *prejudice*.

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 20020046294 A1 to Brodsky et al. (hereinafter *"Brodsky"*) in view of U.S. Patent No. 7,039,597 to Notani et al. (hereinafter *"Notani"*) and in further view of Understanding ebXML, UDDI and XML/EDI, XML/BDI Group by David Webber (hereinafter *"Webber"*).

Applicants note with thanks the Examiner's response of April 27, 2011. Applicants further notes with thanks the Examiner's withdrawal of the previous rejections of Claims 1-31 stand rejected under 35 U.S.C. § 112, second paragraph.

Applicants respectfully submit that all of Applicants arguments are without *prejudice* or *disclaimer*. In addition, Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicants further respectfully submit that by not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are considered sufficient to overcome the Examiner's rejections. In addition, Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application.

I.   Rejections Under 35 U.S.C. § 103(a)

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over *Brodsky*, *Notani*, and *Webber*.

Applicants respectfully submit that Applicants' claims in their current form contain unique and novel limitations that are not disclosed by *Brodsky, Notani,* and *Webber*, whether taken individually or in combination. Thus, Applicants respectfully traverse the Examiner's anticipation obviousness rejection of Claims 1-31 under 35 U.S.C. § 103(a) over *Brodsky, Notani,* and *Webber,* individually or in combination.

In rejecting Claim 1, the Examiner states the following:

> *Brodsky does not specifically teach wherein the meta-models are predefined or newly defined.* However, Notani teaches receive selection of one or more of the predefined meta-model elements and one or more meta-model elements is newly defined by at least one of the enterprises (col. 2, line 35 - col. 3, line 20, col. 18, lines 5-53).

(April 27, 2011 Office Action, page 5). (Emphasis added). Applicants thank the Examiner for noting the shortcomings of *Brodsky* but respectfully disagree with the Examiner's assertions that *Notani* provides these missing elements and respectfully direct the Examiner's attention to column 18, lines 5-53 of the specification of *Notani*, provided below, on which the Examiner relies:

> Extension of Framework
> An important aspect of the present framework is extensibility. Without extensibility, the framework may not be able to handle new situations and challenges with which it is confronted. There can be several different dimensions to this extensibility. For example, *one primary area of extensibility is in the area of semantic object standards. If supported standards do not suffice for a particular problem, then the framework can be augmented with new semantic standards. Additionally the framework allows the building of proprietary semantic standards. Further, the framework can be extended by adding new accessors, transformers, adapters, etc.*

> Collaboration Management
> The present invention may provide for management of collaborations within and between enterprises. Generally described, the present invention may provide a computer implemented process for managing workflows and collaborations distributed between nodes of one or more enterprises. The computer implemented process manages a collaboration by storing a set of predefined functions for the collaboration to be performed at the distributed nodes. The computer implemented process automatically interacts with the collaboration at each of the nodes to perform the predefined functions. As used herein, "each" means at least a subset of the identified items. *The computer-implemented process may be a high-level collaboration generated and processed by the global collaboration designer and the global collaboration manager as previously described in connection with other collaborations of the system or other suitable process capable of managing a collaboration across multiple nodes.*

> The predefined functions may be functions for generating, deploying, monitoring, or otherwise interacting with a collaboration.

FIG. **19** illustrates a flow diagram for generating a collaboration between a plurality of enterprises in accordance with one embodiment of the present invention. Referring to FIG. 19, the method for generating a collaboration begins at step **160** at which a preliminary collaboration is received from a first enterprise. ***The collaboration is preliminary in that it may be commented upon or modified by other enterprises involved in the collaboration.*** The preliminary collaboration may be generated or otherwise provided by the first enterprise. (Emphasis added).

As shown above, the portions of *Notani* on which the Examiner relies fails to disclose at least the element of Claim 1 of "***receiv[ing] selections of one or more of the predefined meta-model elements and one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model.***"

By contrast, the portion of *Notani* on which the Examiner relies merely discloses, among other things, that a framework may be augmented with new standards for semantic objects, the framework allows for the building of proprietary standards, and those involved in a collaboration may comment on or modify the collaboration. Applicants respectfully submit that this is not analogous to "***receiv[ing]*** selections of one or more of the predefined meta-model elements and ***one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model.***" More specifically, Applicants respectfully submit that the Examiner misinterprets the fact that a framework may be augmented with new standards, allows for the building of proprietary standards, and allows for commenting and modification of a collaboration as ***actually receiving a selection of one or more meta-model elements that is newly defined by an enterprise that is to be incorporated into a negotiated metamodel***.

The Examiner further states the following:

> The applicant argues on page 16 of applicants arguments that the combination of Notani and Brodsky fail to teach "receiving selection of one or more of the predefined meta-model elements and one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model." The examiner respectfully disagrees. As can be seen in the applicants own specification the only support for a new negotiated meta-model is found in paragraph one of page 14. "one or more meta-models that have been used by enterprises 12 for previous transaction and can be modified, for example ... to form new negotiated meta-models. Based on the broadest reasonable interpretation of the newly defined meta-model elements is any type of modified meta-model used for collaboration. ***As can be seen in at least in col. 8, lines 10-21 there is a switch or***

modification to the meta-model used for negotiation. The meta-model is modified from one format to another.

(April 27, 2011 Office Action, page 2). (Emphasis added). Applicants respectfully disagree with the Examiner's assertions and respectfully direct the Examiner's attention to column 8 lines 12-21 of the specification of *Notani*, provided below, on which the Examiner relies:

> Several format standards can be supported by the present global collaboration manager, including XML, EDI format, Java Serial Streams (referred to as Java format and not to be confused with the Java Language or Java Platform) and IIOP Serial Streams. Of these, in one embodiment, the Java format is the primary format, and the rest are derived formats. Because the Java Format can contain the behavior to produce the other formats, it has been chosen as the primary format. XML, EDI and IIOP formats can be derived from the Java Format.

As shown above, the portions of *Notani* on which the Examiner relies fails to disclose at least the element of Claim 1 of "*receiv[ing]* selections of one or more of the predefined meta-model elements and *one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model*," as required by Claim 1, or even "*there is a switch or modification to the meta-model used for negotiation*," as asserted by the Examiner.

In fact, as shown above, the disclosure of the portions of *Notani* relied upon by the Examiner is silent and therefore, fails to even disclose *newly defined meta-model elements*, let alone *meta-model elements*, as required by Claim 1. Furthermore, it is unclear what the Examiner means by a "*switch*" or "*modification*," where this "*switch*" or "*modification*" is disclosed in *Notani*, or even how a "*switch or modification to the meta-model*" as asserted by the Examiner relates to *receiving selections of* "*one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model*," as required by Claim 1. *Applicants respectfully request the Examiner to clarify* what the Examiner means by a "*switch*" or "*modification*" and specifically what the Examiner means by "*there is a switch or modification to the meta-model used for negotiation*."

Furthermore, *Notani*, merely makes mention of, among other things, several format standards. However, a *mere generalization* of several format standards does not equate to an

explicit disclosure of *receiving selections of "one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model."* In fact, the portions of *Notani* relied upon by the Examiner is silent, and thus, fails to expressly or inherently disclose any detail as to how a primary or derived format is produced and thus, also fails to disclose the above-referenced elements of Applicants claims. In addition, *Notani* merely discloses, among other things that the Java Format can contain the behavior to produce the other formats, however, this is simply an abstraction that describes a possible process, which "**can**" be performed, but how it does so is left undisclosed in the cited portions of *Notani* relied upon by the Examiner. Furthermore, how it relates to the subject application is left unexplained by the Examiner. Thus, *Applicants respectfully request clarification from the Examiner.*

Applicants respectfully submit that while *Notani* fails to expressly disclose these limitations of Claim 1, as discussed above, the portions of *Notani* relied on by the Examiner also fail to inherently disclose these elements. There is also no teaching, motivation or suggestion to render obvious Claim 1 as *Notani*'s disclosure of modifying a framework by allowing proprietary standards to be used does not suggest to one of ordinary skill in the art that it would be obvious to incorporate a *newly defined meta-model element* into a negotiated meta-model when there are pre-defined meta-model elements available.

It appears that the Examiner acknowledges that *Notani* fail to expressly or inherently disclose *receiving selections of "one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model,"* as required by Claim 1, by stating the following:

> The feature of "receiving selections of one or more of the *predefined* meta-model elements and one or more meta-model elements that is *newly defined* by at least one of the enterprises for negotiation and incorporated into a negotiated metal-model" is further evidenced by *Webber* pg. 119-123, specifically page 123. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Brodsky and Notani to further include the details related to *newly defined meta-model elements*. The prior art reference are all related to negotiating collaboration software. Combining Webber with Brodsky and Notani would further expand upon the teachings of a *newly defined meta-model element*.

(April 27, 2011 Office Action, page 6). (Emphasis added). Applicants thank the Examiner for noting the shortcomings of *Notani* but respectfully disagree with the Examiner's assertions that

Webber provides these missing elements and respectfully direct the Examiner's attention to the pertinent portions of page 123 of the *Webber* reference, provided below, on which the Examiner relies:

> The ebXLM initiative has concentrated on modeling tools to capture the business processes, not just the transactions, and storing standard definitions in globally accessible registries (repositories). If this is carried out correctly, the small business can avoid having to undertake costly and complex modeling, while still being able to quickly and easily tap into existing process models and off-the-shelf applicant solutions. The XML/EDI guidelines have added two further key components – process templates and software agents – to assist in this. The idea is to provide dynamic software processes based on XML representations by using the ability of XML to define not just the data but also processing scripting systems. The ebXML work sees this as a second phase requirement; with the first phase being based on simpler, rigid, well-understood, more static interfaces.

As shown above, the portions of *Webber* on which the Examiner relies fails to disclose at least the element of Claim 1 of *receiving selections of "one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model."* By contrast, the portion of *Webber* on which the Examiner relies merely discloses, among other things, storing standard definitions of a business process. Applicants respectfully submit that this is not analogous to *newly defined meta-model elements*, as required by Claim 1. That is, *Webber* does not disclose, teach or even hint at "meta-model elements that [are] *newly defined* by at least one of the enterprises for negotiation."

While further distinctions exist between Claim 1 and the cited references, some of which have already been made of record, the failure of *Brodsky, Notani,* and *Webber,* taken individually or in combination, to disclose at least the elements of *"receiv[ing]* selections of one or more of the predefined meta-model elements and *one or more meta-model elements that is newly defined by at least one of the enterprises for negotiation and incorporation into a negotiated meta-model,"* as discussed in detail above, is more than sufficient to provide a showing that Claim 1 is not rendered obvious by the cited references.

Accordingly, Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) as obvious over *Brodsky, Notani,* and *Webber* be withdrawn.

II. **The Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Brodsky-Notani-Webber* Combination**

Applicants respectfully submit that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Brodsky, Notani,* and *Webber,* either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

(1)   Determining the scope and content of the prior art;
(2)   Ascertaining the differences between the claimed invention and the prior art; and
(3)   Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, "While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls." (*KSR*, 550 U.S. at __, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel "*ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the "*factual findings made by Office personnel are the necessary underpinnings to establish obviousness.*" (*id.*). Further, "*Office personnel must provide an explanation to support an obviousness rejection* under 35 U.S.C. 103. (*id.*). In fact, "35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed" and "clearly setting forth findings of fact and the rationale(s) to

support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability." (*id.*).

With respect to the subject application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Brodsky, Notani,* and *Webber.* The Office Action merely states that "applying a predefined meta-model and one or more newly defined meta-model elements to Brodsky would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for quicker collaboration in the case of the predefined meta-model elements and allow for the enterprise to submit a new type of meta-model element in the case of a newly defined element" and it "would have been obvious to one or ordinary skill in the art at the time of the invention to modify Brodsky and Notani to further include the details related to newly defined meta-model elements." (April 27, 2011 Office Action, pages 5-6). Applicants respectfully disagree and respectfully submit that the Examiner's conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Brodsky, Notani,* and *Webber. Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to "ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in "determining the scope and content of the prior art" such as, for example, "Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application." (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the "broadest reasonable interpretation consistent with the specification." (*See* Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any "*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not

provided *an indication of the level of ordinary skill. Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and *See* 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants' invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Brodsky, Notani, Webber, and Applicants' claimed invention would have been obvious to one of ordinary skill in the art.* The Office Action merely states that "[b]ecause technology is rapidly changing the newly defined element allows for a change in the current collaboration that might be required for purposes of speed and accuracy" and that because the "prior art references are all related to negotiating collaboration software [… combining] Webber with Brodsky and Notani would further expand the techings of a newly defined meta-model element." (April 27, 2011 Office Action, page 6). Applicants respectfully disagree and further respectfully request clarification as to how this statement *explains why the difference(s) between the proposed combination of Brodsky, Notani, Webber, and Applicants' claimed invention would have been obvious to one of ordinary skill in the art.* Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*"

(Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*" (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "'[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*'" (*KSR*, 550 U.S. at __, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

(A)   Combining prior art elements according to known methods to yield predictable results;

(B)   Simple substitution of one known element for another to obtain predictable results;

(C)   Use of known technique to improve similar devices (methods, or products) in the same way;

(D)   Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E)   "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F)   Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G)   Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicants respectfully submit that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicants' claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Brodsky, Notani,* and *Webber to render obvious Applicants' claimed invention*. As shown above, the Examiner's unsupported conclusory statements *do not adequately provide clear articulation of the reasons why Applicants' claimed invention would have been obvious*. In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicants' claimed invention.

Thus, if the Examiner continues to maintain the obviousness rejection based on the proposed combination of *Brodsky, Notani,* and *Webber*, *Applicants respectfully request that the Examiner*

provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.

III.   <u>Applicants' Claims are Patentable over *Brodsky, Notani,* and *Webber*</u>

Applicants respectfully submit that, as discussed above, Claims 1, 11, 21, and 31 are considered patentably distinguishable over *Brodsky, Notani,* and *Webber* for at least the reasons discussed above in connection with Claim 1.

Furthermore, with respect to dependent Claims 2-10, 12-20, and 22-30: Claims 2-10 depend from Claim 1; Claims 12-20 depend from Claim 11; and Claims 22-30 depend from Claim 21. As mentioned above, each of Claims 1, 11, 21, and 31 are considered patentably distinguishable over *Brodsky, Notani,* and *Webber*. Thus, dependent Claims 4, 5, 14, 15, 24, and 25 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, Applicants respectfully submit that Claims 1-31 are not anticipated by *Brodsky, Notani,* and *Webber*. Applicants further respectfully submit that Claims 1-31 are in condition for allowance. Thus, Applicants respectfully request that the rejection of Claims 1-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-31 be allowed.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Respectfully submitted,

July 22, 2011
Date

/Steven J. Laureanti/signed
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